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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,322	12/07/2000	Jens Jensen	5986/OH648	1566

7590                  01/13/2005

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805 Third Avenue  
New York, NY 10022

EXAMINER
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FREJD, RUSSELL WARREN

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/732,322	JENSEN, JENS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Russell Frejd	2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 August 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-14 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

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***Examination of Application #09/732,322***

1. Claims 1-14 of application 09/732,322, filed on 7-December-2000, are presented for examination. This paper is in response to applicant's amendment received on 11-August-2004.

***Specification Objections***

2. The previous office action from the examiner contained the following objection: *The disclosure is objected to because the specification contains an appendix. Patent Rules (Section 1.96) stipulate that only "computer program listings" may form an appendix. For this reason, applicant's appendix will not be printed if this application is issued. Furthermore, applicant must delete all reference to the appendix from the specification. If the specification requires this appendix, the information from the appendix may be amended into the specification, but however, no drawings will be allowed.*

2.1 The amendment received on 11-August 2004 contained an edited version of §1.96, explaining in detail how the present invention is "NOT" a computer program listing as described in §1.96 and MPEP 608.05, and therefore is not subject to the restrictions detailed in those sections. As a result, applicant argued that the Theorem proofs of Appendix A, the list of references in Appendix B, and the tables of Appendix C "are properly part of applicant's disclosure and must be printed when a patent is granted."

2.2 The examiner respectfully disagrees with applicant's argument, and posits that the only provisions in the Patent Rules [§1.96] or the MPEP [608.05] for an appendix to the specification is for the deposit of computer program listings. For this reason, the examiner sees no reason why applicant's Theorem proofs and list of references were not included in the body of the

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specification (see specification on p. 8, section III. Mathematical Background, line 2, and p. 28, line 1). Furthermore, the examiner posits that the tables should be included in the description portion of the specification as described in §1.58 (see pages 20 and 21). In any event, the examiner argues that only computer program listings are permitted in specification appendices, and all other narrative material is objected to under §1.96, and the requirement made that the material be included in the specification pursuant to §1.52.

***Information Disclosure Statement***

3 The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

3.1 The IDS submitted on 7-December-2000 listed four references which appear in the present Appendix B as references [1], [2], [6] and [7]. The remaining references [3], [4], [5], [8] and [9] are not listed on a form PTO-1449, and therefore have not been considered by the examiner.

***Specification - Improper Incorporation by Reference***

4. The attempt to incorporate subject matter into this application by reference to two non-patent publications (reference [4] pages 11-12, specification, and reference [5] pages 11, 14 and 24), which appear to consist of essential matter, is improper because there is insufficient

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identification so as to direct the Examiner or future potential readers to the referenced material.

The Examiner requires this information in order to properly review Applicant's specification.

Furthermore, if the current application issues as a patent, Applicants will be required to physically incorporate the incorporated material into the instant specification. Please refer to section 608.01(p), which recites:

**"INCORPORATION BY REFERENCE"**

The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. General Electric Co. v. Brenner, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Commissioner has elected to exercise that discretion. Section A provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section B provides guidance for incorporation by reference in benefit applications; i.e., those domestic (35 U.S.C. 120) or foreign (35 U.S.C. 119(a)) applications relied on to establish an earlier effective filing date.

**A. Review of Applications, Which Are To Issue as Patents.**

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112.

Material nevertheless may be incorporated by reference, Ex parte Schwarze, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application.

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Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices,

(2) prior filed, commonly owned U.S. applications, or (3) non-patent publications however, hyperlinks and/or other forms of browser executable code cannot be incorporated by reference. See MPEP § 608.01. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). **In addition to other requirements for an application, the referencing application should include an *identification* of the referenced patent, application, or publication.** Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Application No. \_\_\_\_\_ left blank in the application as filed can be found in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103).

#### 1. Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be canceled by amendment and may be substituted by reference to a U.S. patent or an earlier filed pending U.S. application. The amendment must be accompanied by an affidavit or declaration signed by the applicant, or a practitioner representing the applicant, stating that the material canceled from the application is the same material that has been incorporated by reference.

If an application as filed incorporates essential material by reference to a U.S. patent or a pending and commonly owned U.S. application, applicant may be required prior to examination to furnish the Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application. However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required.

**In re Application of: Jensen**

**Prior to allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has been published or issued as a patent.** If the referenced application has been published or issued as a patent, the examiner shall enter the U.S. Patent Application Publication No. or the U.S. Patent No. of the referenced application in the specification of the referencing application (see MPEP § 1302.04). **If the referenced application has not been published or issued as a patent, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.**

2. Improper Incorporation

Reliance on a **commonly assigned copending application** by a **different inventor** may ordinarily be made for the purpose of completing the disclosure. See In re Fried, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and General Electric Co. v. Brenner, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). **Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date.** White Consol. Indus., Inc. v. Vega Servo-Control, Inc., 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); In re Scarbrough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); In re Glass, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974)."

**Claim Rejections under 35 U.S.C. § 102**

5. The claim rejections applied to claims 1-14 in the previous office action are removed by the examiner, and the claims are considered allowable over the prior art of record at this time.

**Response Guidelines**

6. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

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7. Any response to the Examiner in regard to this non-final action should be

**directed to:** Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, or the examiner's supervisor, Jean Homere, telephone number (571) 272-3780.

**mailed to:** Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** (703) 872-9306

*Hand-delivered responses should be brought to 220 South 20<sup>th</sup> Street, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA., 22202.*

Date: 10-January-2005

Russell Frejd

RUSSELL FREJD  
PRIMARY EXAMINER